

The opinion in support of the decision being entered today was not written
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Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte DAVID R. MONTAGUE

Appeal No. 2004-1339
Application No. 09/488,079

ON BRIEF

Before FRANKFORT, BARRETT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 28,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to product labeling and, more particularly, to novel systems and methods for providing electronic feedback and user information by registration with vendors of products (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Dlugos, Sr. et al. (Dlugos) 5,153,842 Oct. 6, 1992

Claims 1, 2, 5 to 12, 15 to 19, 22 and 24 to 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dlugos.

Claims 3, 4, 13, 14, 20, 21 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dlugos.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 36, mailed January 14, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 33, filed October 27, 2003) and

reply brief (Paper No. 37, filed March 16, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claims 1, 2, 5 to 12, 15 to 19, 22 and 24 to 28 under 35 U.S.C. § 102(b) as being anticipated by Dlugos.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellant argues (brief, pp. 5-7; reply brief, pp. 2-5) that Dlugos does not disclose a computer readable medium storing instructions executable by a computer of a purchaser/user as recited in independent claims 1, 11, 18, 24, 27 and 28. We agree.

Dlugos discloses an integrated circuit card having a microprocessor, a memory and input and output devices. The card stores information regarding a parcel. The card is secured to the parcel and serves as a label. Referring to Figures 1A and 6, an integrated circuit package label 2 is shown in the form of a conventional integrated circuit card (or "smart card") and includes a card shaped plastic body 10. The plastic body 10 includes a central section 16 that holds the electronic components of label 2.

Dlugos' label 2 has a top surface 18 on which information 19 is visible, such as the name of the owner or issuer of label 2. Information 19 may be printed or silk screened on central section 16. Also visible on top surface 18 is display 60 which includes LCD segments 66 adapted to display bar codes. Also present on top surface 18 are keyboard 20, solar cell bank 30, sensor 40 and light emitting diode (LED) 50.

The electronic components of Dlugos' label 2 are shown in block diagram form in Figure 2 and include a microprocessor 100. Microprocessor 100 is connected to a memory 104 (shown in more detail in Figure 9) which includes a read only memory

(ROM) 130 for storing operating software for label 2. Memory 104 further comprises random access memory (RAM) 132 for use during operation of label 2, and nonvolatile memory such as electrically erasable programmable read only memory (EEPROM) 134. ROM 130, RAM 132 and EEPROM 134 are each connected to microprocessor 100 via appropriate data, address and control lines 144 and are also connected to a power supply via appropriate circuitry 146. EEPROM 134 may comprise a write protected section 138 for storing serial numbers or other identification data, or other information stored therein by the manufacturer, distributor or owner and intended to be maintained permanently for the life of label 2. Section 138 may comprise an openly readable subsection 140 and a selectively readable subsection 142, subsection 142 being readable only after a password is input or another security requirement is complied with.

Figures 4 and 5 of Dlugos show label 2 attached to parcel P. Label 2 is held within envelope 80. Envelope 80 may be formed of, for example, a clear plastic film or a protective packing material containing air bubbles. Envelope 80 has a top portion 86 and a bottom portion 84. An adhesive layer 82 is provided on the outside surface of bottom portion 84. Adhesive layer 82 is in contact with and adheres to top surface 90 of parcel P, thus attaching label 2 to parcel P.

Dlugos teaches the following potential application for an integrated circuit package label (column 8, line 10, to column 9, line 62):

By way of example, a parcel carrier can supply labels to its customers for attachment to parcels that will be transported by the carrier.

The carrier's customer (sender of the parcel) uses the label from the beginning to the end of the order fulfillment cycle. Initially, the sender inputs into the label sender information including name, address and sender identification number. Alternatively, this information may already have been input by the carrier or may be present as a result of a previous use of the label by the sender. Immediately after an order is received, recipient information (such as billing name and address, account number), order information (such as order number, item numbers, quantities, prices), and shipping information (such as destination address, mode of delivery, handling instructions), are all input into the label. The label is then delivered to the warehouse in lieu of a picking list. At the warehouse, a terminal reads the label and either prints a picking list, or carries out an automated picking process.

From this point forward the label accompanies the order to its destination, with information read from the label and additional information written into the label at various stages along the way. For instance, upon completion of the picking process, information can be added reflecting date and time of picking, identifying the employee responsible for picking and recording the serial numbers of the items picked for the order. If it was not possible to fulfill the order, or if the order was only partially fulfilled, or fulfilled with substitute items, appropriate information can be written into the label. The label can later be read, if desired, as part of a quality control check for the picking process.

When the order is packed and prepared for shipment, the label is attached to the parcel as described above. Information from the label is read by a parcel scale or computerized parcel shipping system (also known as a manifesting system) or a terminal interfaced thereto for such purposes as selecting routes and shipping modes, calculating shipping charges, preparing manifests, billing, maintaining accounting records. Additional information is written into the label, including some or all of: date and time of shipment, routing codes (which may include a postal zip code), shipping mode, shipping charges, handling charges, manifest number, invoice number, weight of parcel.

Information read by a terminal 300 can be uploaded to a host computer so that a central record of order fulfillment can be maintained.

It should be understood that the shipper's procedures may call for some of the input information to be stored only in read protected section 136 of the label's memory. For example, the shipping charge may be stored in read protected section 136, with the carrier enabled to read the shipping charge information but the recipient (shipper's customer) not so enabled. In that case, the shipper will be free to bill the recipient a "shipping and handling" charge that is higher than the actual shipping charge without fear that the recipient will raise the actual charge as an objection to the billed "shipping and handling charge." As another example, the value of the goods shipped may be stored in read protected section 136 so that especially valuable parcels cannot be readily identified by individuals who may be inclined to steal them.

Once the parcel has been turned over to the carrier, the carrier may read the label for such purposes as recording date and time of receipt, or verifying manifest or waybill information or for receiving notice of C.O.D. and/or insurance obligations. Additional information written into the label at this point may include date, time and place of receipt, carrier's parcel identification number for tracking purposes, routing information (such as airport or sorting codes), an indication that shipping charges (including C.O.D., insurance, etc.), have been paid or that the parcel has been cross-checked against a manifest, or information necessary for the carrier to bill the sender.

An automated sorting system, comprising one or more terminals 300 or the like, reads routing information through bar code scanner 308 or through sensor 306, and directs the parcel into an appropriate bin for dispatch to the next point en route. This process may occur at several points before the parcel is delivered. At each sorting point, or at other points along the way, terminals can be used to read parcel identification information from the label so as to track the progress of the parcel through the carrier's system. At those same points or others, the time, place and location of sorting or handling may be written into the label, so that the parcel carries with it a record of its path through the system.

In one type of application of the integrated circuit label, the carrier removes the label from the parcel at the destination, perhaps after a final read and/or write operation for recording date, time and place of delivery, payment of C.O.D. charges, name of individual recipient, and so forth. The label is returned to the carrier's premises, where some or all of the information accumulated

during fulfillment, shipment and delivery can be read by a terminal and uploaded to a host computer for billing, market analysis, operational analysis or other purposes.

Appropriate nonpermanent portions of the label's memory are then cleared, the label is provided to another shipper or the same shipper and the entire process is repeated. In this way each label may be reused many times.

Alternatively, the label remains attached to the (parcel) after delivery. The label is read by the recipient's terminal for such purposes as matching to a purchase order, checking the contents of the parcel, verifying the invoice, or auditing the carrier's charges or service performance. If the items contained in the parcel are to be resold by the recipient, the label may continue to accompany those items, undergoing virtually the same process as described before. Otherwise, when the recipient has read all the information he requires from the label, he may clear the appropriate nonpermanent portions of the memory and then either reuse the label on his own outgoing parcel or return the label to the carrier or the shipper for reuse.

After reviewing the teachings of Dlugos, we conclude that the integrated circuit card label of Dlugos does not store instructions executable by a computer of a purchaser/user, instead the integrated circuit card label of Dlugos stores instructions executable by its own microprocessor. As such, the claimed subject matter is not anticipated by the integrated circuit card label of Dlugos.

Since all the limitations of independent claims 1, 11, 18, 24, 27 and 28 are not disclosed in Dlugos for the reasons set forth above, the decision of the examiner to reject independent claims 1, 11, 18, 24, 27 and 28, and claims 2, 5 to 10, 12, 15 to 17, 19, 22, 25 and 26 dependent thereon, under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of dependent claims 3, 4, 13, 14, 20, 21 and 23 under 35 U.S.C. § 103 as being unpatentable over Dlugos since the examiner has not presented any evidence as to why the subject matter of independent claims 1, 11, 18, 24, 27 and 28 would have been obvious at the time the invention was made to a person of ordinary skill in the art.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 5 to 12, 15 to 19, 22 and 24 to 28 under 35 U.S.C. § 102(b) is reversed and the decision of the examiner to reject claims 3, 4, 13, 14, 20, 21 and 23 under 35 U.S.C. § 103 is reversed.

REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

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LEE E. BARRETT
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